

REMARKS

In the final Office Action¹, the Examiner objected to the drawings; objected to the specification; rejected claims 1-4, 6-15, and 17-23 under 35 U.S.C. § 112, first paragraph; rejected claims 1-4, 6-15, and 17-23 under 35 U.S.C. § 112, second paragraph; rejected claim 23 under 35 U.S.C. § 101; and rejected claims 1-4, 6-15, and 17-23 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,792,113 to Ansell et al. ("*Ansell*") in view of U.S. Patent No. 6,726,100 to Lauper et al. ("*Lauper*").

By this Amendment, Applicant amends claims 1, 12, and 23.

In the Advisory Action, the Examiner withdrew the objection to the drawings, the rejection of claims 1-4, 6-15, and 17-23 under 35 U.S.C. § 112, first paragraph, the rejection of claims 1-4, 6-15, and 17-23 under 35 U.S.C. § 112, second paragraph, and the rejection of claim 23 under 35 U.S.C. § 101.

The Advisory Action does not address the objection to the specification. Applicant maintains that the remarks submitted at pp. 7-8 of the Amendment After Final filed February 22, 2008 are sufficient to overcome the objection. Therefore, Applicant respectfully requests the Examiner to withdraw the objection to the specification.

Applicant respectfully traverses the rejection of claims 1-4, 6-15, and 17-23 under 35 U.S.C. § 103(a).

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See id. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1996) The factual inquires . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly

articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1, for example, recites a content usage control apparatus, comprising, among other things, a “registration means for registering the first user identification information in a database, and for subsequently registering a second user requesting use of the content by replacing the first user identification information in the database with second user identification information identifying the second user.”

The cited references fail to teach or suggest at least the claimed “replacing the first user identification information in the database with second user identification information identifying the second user.”

Ansell discloses using keys to access content using a passport, and the passport can be converted from a “machine-bound state to [a] user-bound state” (*Ansell*, abstract). The machine-bound passport includes a machine-bound key that allows any user of a given machine to access data content (*Ansell*, abstract and col. 7, lines 51-53). In the user-bound state, the user can transport the passport between different machines (*Ansell*, col. 7, lines 46-49). A limited number of machine-bound keys can be added to a user-bound passport (*Ansell*, col. 42-43).

The Examiner alleges that *Ansell*’s “machine bound keys [are] a form of user identification” (Advisory Action at p. 4). Applicant respectfully disagrees. *Ansell*’s machine bound keys are, at best, a form of machine identification. *Ansell* states, “private key 2404 . . . of machine-bound passport 148B is encrypted using as a key the hardware identifier of the computer system to which passport 148B is bound” (emphasis added)(*Ansell*, col. 9, lines 57-59). Further, *Ansell* states that “[m]achine-bound

passport 148B . . . is bound to client computer system 104 and not to any particular user." (emphasis added) (*Ansell*, col. 9, lines 52-53). Moreover, *Ansell* illustrates an exemplary machine-bound passport in FIG. 24, and neither the machine-bound private key 2404 nor the machine-bound passport includes any information identifying a user (*Ansell*, col. 8, line 33).

In contrast to the machine-bound passports and keys, user-bound passport illustrated in FIG. 23 includes private user information 2306 (*Ansell*, col. 4, line 57). *Ansell* does not disclose or suggest that when the machine -bound keys are added to the user-bound passport, the private user information 2306 is "replaced" by information identifying another user. Therefore, *Ansell* does not teach or suggest "replacing the first user identification information in the database with second user identification information identifying the second user," as recited by independent claim 1.

Lauper fails to cure the deficiencies of *Ansell*. *Lauper* discloses a method for updating time-limited parameters in a chip-card, such as lists of blocked user chip-cards (*Lauper*, abstract). *Lauper* does not disclose that the lists include user identifications, however. Rather, *Lauper's* lists include identifications of the chip-cards themselves (*Lauper*, col. 4, lines 29-31). *Lauper*, therefore, does not teach or suggest the claimed "replacing the first user identification information in the database with second user identification information identifying the second user," as recited by independent claim 1.

As explained above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, no reason has been clearly articulated

as to why the claim would have been obvious to one of ordinary skill in view of *Ansell* and *Lauper*. Accordingly, no *prima facie* case of obviousness has been established with respect to claim 1. Independent claims 12 and 23 distinguish over *Ansell* and *Lauper* for at least the same reasons as claim 1. Claims 2-4 and 6-11 depend from claim 1, and claims 13-15 and 17-22 depend from claim 12., and are allowable at least due to their dependence from allowable base claims. Applicant therefore respectfully requests the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

The dependent claims recite additional features not taught by the cited references. For example, claim 10 recites “A content usage control apparatus . . . wherein the change limitation means charges fees for changing the maximum number of times user identification information can be replaced” (emphasis added). The Examiner cites to a number of different passages of *Ansell* in addressing claim 10 (Final Office Action at p. 12). However, of the cited portions of *Ansell*, only col. 3, lines 3-9 has any apparent relevance to charging fees. Col. 3, lines 3-9 of *Ansell* merely discloses that a user-bound passport can include credit card information, so that sharing a user-bound passport requires a user to share credit card information. However, *Ansell* does not indicate circumstances under which the credit card is charged. Therefore, *Ansell* does not teach or suggest the claimed “wherein the change limitation means charges fees for changing the maximum number of times user identification information can be replaced” as recited by dependent claim 10 (emphasis added). *Lauper* fails to cure the deficiencies of *Ansell*. Dependent claim 21 is allowable over *Ansell* and *Lauper* for at least the same reasons as discussed for claim 10.

In view of the foregoing remarks, Applicant respectfully requests reconsideration of the application and withdrawal of the rejections. Pending claims 1-4, 6-15, and 17-23 are in condition for allowance.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: /David W. Hill/
David W. Hill
Reg. No. 28,220